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EXAMINER

CARIASO, ALAN B

ART UNIT PAPER NUMBER

2875

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,400

Applicant(s)

DOREATHA L. BATTLE

Examiner

Alan Cariaso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: .

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the power supply in operative relation with the plurality of light emitting elements and coupled with the housing, the power supply being a battery and solar energy system, and plural support members having a flange portion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because the three figures in figure 1 should be labeled as fig.1a, fig.1b & fig.1c as listed in the Brief Description of the Drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 1, lines 4-5, the phrase "the housing defining a plurality of apertures *therethrough*" is indefinite as being misdescriptive. It appears that only the front part of the housing are formed these plurality of apertures and not through the housing.
6. Claim 7, line 5, the limitation "windowsill" is indefinite as being the same as or different from the discloses "window parapet". Different terms directed to the same part should be both shown as equivalent in the specification.
7. Claim 9 is indefinite for depending on itself.
8. Claim 14, lines 7-9, the limitation "a plurality of support members ... having a flange portion" is indefinite as appearing to be misdescriptive. The flange support disclosed at least in figure 2 lacks any descriptive support of being associated with a plurality of support members. The plurality of the supports of figure 1 appears to be unrelated to the flange support for a window.
9. Claims 17 and 20, the phrase "the light emitting elements illuminate when it is substantially dark and do not illuminate when it is substantially light" is indefinite as lacking structure to support this function.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 1-4, 14-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by ABTAHI (US 5,890,794).

12. ABTAHI discloses plural light emitting elements (144-fig.14) situated in apertures (30) of a housing (140); a power supply (180) coupled to the housing (140) and being rechargeable batteries (180) and solar cells (184); housing (140 or 60) is transparent/translucent and inherently rigid material (64,152); a plurality of support members having a flange portion (170-fig.11) coupled to the housing (140); and circuitry (189) which switches the light emitting elements at least on/off.

13. As for phrase in claims 17 and 20, "the light emitting elements illuminate when it is substantially dark and do not illuminate when it is substantially light", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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14. Claims 1-6, 8, and 11-20 are rejected under 35 U.S.C. 102(b) as being anticipated by CHEN (US 5,630,660).

15. CHEN discloses plural light emitting elements (16-fig.6) positioned in apertures of a housing (18-fig.6); a power supply (19-fig.6 or 60-fig.3) coupled to the housing (30) and being batteries (60) and solar cells (19), and a circuit switch (col.4, lines 32-35) that operates the lighting elements; housing (18) is transparent/translucent and inherently rigid material; a hook (12,13) coupled with a portion of the housing (10-fig.1); a plurality of support members (20,40) coupled to the housing (10,30) and having an actuator (col.4, lines 40-58) that enables telescoping (20,21) of the supports.

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over CHEN (US 5,630,660).

18. CHEN discloses applicant's invention except a removable back cover portion. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to provide the housing of CHEN to include at least a removable cover portion of the housing for the purpose of removably replacing batteries or light sources since it



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was known in the art to provide a cover portion as part of a light housing for access to the electrical components.

***Allowable Subject Matter***

19. Claims 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. CONLIN et al (US 4,718,185) and WILLIAMS (US 4,843,525) show other transparent housings with plural light sources, self-powering means that include solar cells and batteries, and plural supports one of which can telescope. CHU (US 5,453,729) and OTEMA (US 6,364,273) show other light housings having protruding lugs and hooks associated with plural supports, respectively.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952. The examiner can normally be reached on M-F (9:00-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Alan Cariaso  
Primary Examiner  
Art Unit 2875

AC  
December 16, 2002